

REMARKS

The Office Action has been received and reviewed. In the Office Action, claims 1-52 were rejected. In response to the Office Action, applicant has provided a new declaration, amended some of the claims, provided new drawings and submits the following remarks.

If there are questions about this *Response*, please contact the undersigned. In view of the remarks, applicant respectfully requests allowance of the claims.

Claim Amendments

Claims 1, 13, 24, 28, 39, 49 have been amended herein to more clearly indicate what is meant by the term "associated access code" and the term "associated password." Claim 13 has been amended herein solely to expedite prosecution. Claim 28 has been amended to change "data base" to read "database," so that the same term is used throughout the claims. Claim 36 has been amended to correct an oversight in the original. Claim 52 has been amended herein to more clearly indicate to whom the description is provided. It is respectfully submitted that the amendments do not introduce new matter. In particular, support for the amendments to claims 1, 13, 24, 28, 39 and 49 can be found in the specification generally, and in particular at page 6, line 22 through page 7, line 9.

Claim Of Priority

Applicant submits herewith a new declaration, which includes the proper serial number for the provisional patent application misidentified in the originally filed declaration.

Drawings

At page 3 of the Office Action, the drawings were objected to. The *Notice Of Draftsperson's Patent Drawing Review* indicates the numbers, reference characters and legends require attention. Enclosed are formal drawings which address these concerns. The formal drawings include the phrase "Substitute Sheet" in the header.

Also at page 3 of the Office Action, it was argued that page 8, lines 15-21 indicate that items 103 and 109 of Figure 2 should be conditional diamonds. It is respectfully submitted that page 8, lines 15-21 do not indicate that items 103 and 109 of Figure 2 should be conditional diamonds. Further, Figure 2 is not misleading, and it is respectfully submitted that making items 103 and 109 into conditional diamonds would change the information provided by Figure 2 in a manner which might be considered misleading. Consequently, the requirement that Figure 2 be amended to show items 103 and 109 as conditional diamonds is inappropriate.

Since the Office Action requires a proposed drawing amendment to avoid abandonment of the application, applicant has included a proposed drawing amendment which adds a conditional diamond to Figure 2. It is respectfully submitted the proposed

amendment to Figure 2 does not add new matter. Further, the proposed amendment to Figure 2, fully addresses the requirement that Figure 2 be amended to include a conditional diamond in keeping with page 8, lines 15-21 of the specification. The proposed drawing amendment corresponding to Figure 2 includes in the header the phrase, "Proposed Substitute Sheet".

Also at page 3 of the Office Action, it was argued that item 215 of Figure 3 should be a conditional diamond. No reason is provided for requiring item 215 to be a conditional diamond. Figure 3 is not misleading, and it is respectfully submitted that making item 215 into a conditional diamond would change the information provided by Figure 3 in a manner which might be considered misleading. Consequently, the requirement that Figure 3 be amended to show item 215 as a conditional diamond is inappropriate.

Since the Office Action requires a proposed drawing amendment to avoid abandonment of the application, applicant has included a proposed drawing amendment which adds a conditional diamond to Figure 3. It is respectfully submitted the proposed amendment to Figure 3 does not add new matter. Further, the proposed amendment to Figure 3, fully addresses the requirement that Figure 3 be amended to include a conditional diamond. The proposed drawing amendment corresponding to Figure 3 includes in the header the phrase, "Proposed Substitute Sheet".

Rejection Of Claim 13 Under 35 U.S.C. 101

In the Office Action, it was argued that claim 13 is directed to non-statutory matter. It is respectfully submitted that claim 13 is directed to statutory subject matter. Nevertheless, in order to expedite prosecution, applicant has decided to amend claim 13 in an effort to expedite prosecution.

In the Office Action, two cases were cited to support the argument that claim 13 is not patentable subject matter. In the Warmerdam decision, the claims were directed at a method for generating a data structure. In the Schrader decision, the claims were directed at a method of competitively bidding on a plurality of related items. In both decisions, the court held that the claims were directed to a mathematical algorithm, which has been classified as an "abstract idea." Therefore, it appears claim 13 was rejected as being nothing more than a mathematical algorithm.

For many years, the courts have wrestled with the distinction between an unpatentable mathematical algorithm and a patentable use of a mathematical algorithm. The cases cited in the Office Action settled on an analysis which attempts to determine whether there is some kind of transformation or reduction of subject matter required by the claim. Under this analysis, there are generally two determinations made when deciding whether a claim is an unpatentable mathematical algorithm or a patentable use of a mathematical algorithm. First, there is a determination as to whether a mathematical algorithm is recited directly or indirectly in the claim. If so,

there is then a determination as to whether the claim as a whole is no more than the algorithm itself.

In the Office Action, there is no detail as to why claim 13 is nothing more than a mathematical algorithm. It is respectfully submitted that claim 13 does not recite a mathematical algorithm, directly or indirectly. Even if a mathematical algorithm is somehow recited, claim 13, as a whole, is more than a mathematical algorithm because claim 13 requires a transformation of subject matter. The transformation required by claim 13 is the step of providing health information descriptions. According to claim 13, if a prospective pair is determined to correspond to one of the associated pairs, then the description in the database is transformed into a description that is provided. Consequently, claim 13 is statutory subject matter.

In the Office Action, it was argued at pages 4 and 5 that claim 13 is a method "without any particular practical application." It is respectfully submitted that claims are not required to recite a "particular practical application." Although there is a requirement that the specification describe the best mode of practicing the invention that is known to the inventor, there is no similar requirement for the claims, and the claims need not be limited to the best mode.

Having said all this, applicant has decided to amend claim 13 in an effort to expedite prosecution. Claim 13 has been amended herein to include the limitations proposed in the Office Action.

Rejection Of Claims Under 35 U.S.C. 102(e)

In the Office Action, it was argued that claims 1-5, 8, 12-16, 19, 23-31, 34, 38-41, 44, and 48-52 are anticipated and therefore not patentable pursuant to 35 U.S.C. 102(e) in view of U.S. patent no. 6,082,776 (Feinberg). It was argued Feinberg discloses a device for storing medical information. The Feinberg device includes compressed medical information and uncompressed human readable information.

With regard to independent claims 1, 13 and 24 of the application, it was argued in the Office Action that Feinberg discloses (a) a database of health information descriptions, and (b) the "associated pair." The Office Action cites Feinberg's (i) Figure 2, item 100, (ii) column 2, lines 50-56, (iii) Figure 2, item 58, (iv) Figure 5, item 52, and (v) column 7, lines 15-44.

It is respectfully submitted that the cited portions of Feinberg do not disclose the associated pair. In Feinberg, there is no access code and password combination which is used by a second computer to provide a health information description or medical information, as the case may be. Further, Feinberg does not disclose a password which is associated with a user of the system, some of whom are not patients identified in the database. Consequently, Feinberg does not anticipate claims 1, 13 or 24.

Further with regard to claims 1, 13 and 24, it was argued in the Office Action that Feinberg discloses a first computer programmed to provide a prospective pair. To support this

contention, the Office Action cites Feinberg's (i) Figure 2, item 54, (ii) Fig. 11B, item 530, and (iii) Fig. 2, item 11. It is respectfully submitted that these portions of Feinberg do not disclose a computer programmed to provide a prospective pair. Consequently, Feinberg does not disclose the "first computer" of claims 1, 13 and 24, which is programmed to provide a prospective pair.

With regard to independent claim 28, it was argued in the Office Action that Feinberg discloses a card having a first computer which is programmed to require entry of a password prior to providing a prospective access code. In support of this argument, the Office action cites Feinberg's (i) Fig. 2, item 10, (ii) column 20, lines 63-67, (iii) column 21, lines 1-11 and (iv) Figure 2, item 54. Although Feinberg may disclose a card and a password, the portions of Feinberg cited in the Office Action do not disclose a computer programmed to require entry of a password prior to providing a prospective access code. Further, Feinberg does not disclose that an acceptable password corresponds to an entity other than the patient. Consequently, Feinberg does not disclose the card of claim 28.

With regard to independent claim 39, claim 39 has been amended herein. It is respectfully submitted that Feinberg does not disclose that at least one of the passwords is associated with an entity other than the patient. Consequently, Feinberg does not disclose the card of claim 39.

With regard to independent claim 49, claim 49 has been amended herein. It is respectfully submitted that Feinberg does

not disclose an associated password corresponding to an entity that is not the patient. Further, Feinberg does not disclose a program code module wherein medical information is caused to be provided if a prospective access code is among a group of associated access codes and a prospective password is among a group of associated passwords. Consequently, Feinberg does not disclose the card of claim 49.

Claims 2-5, 8, 12, 14-16, 19, 23, 25-27, 34, 38, 40, 41, 44, 48 and 50-52 depend from one of the independent claims. As such, claims 2-5, 8, 12, 14-16, 19, 23, 25-27, 34, 38, 40, 41, 44, 48 and 50-52 include all the limitations of the independent claim from which they depend. Therefore, the arguments set forth above with respect to the independent claims are equally relevant to claims 2-5, 8, 12, 14-16, 19, 23, 25-27, 34, 38, 40, 41, 44, 48 and 50-52. Therefore, 2-5, 8, 12, 14-16, 19, 23, 25-27, 34, 38, 40, 41, 44, 48 and 50-52 are allowable.

Rejection Of Claims Under 35 U.S.C. 103(a)

At pages 16-44 of the Office Action, claims 6, 7, 9-11, 17, 18, 20-22, 32, 33, 35-37, 42, 43 and 45-47 were rejected under 35 U.S.C. 103(a). In the Office Action, it was argued that these claims would have been obvious to one having ordinary skill in the art at the time the invention was made. To support this argument, Feinberg in view of U.S. patent number 5,771,291 (Newton et al.) and in view of an article titled *Smart Cards and Biometrics* (Corcoran et al.) were cited. Feinberg is discussed above. Both Newton et al. and Corcoran et al. are cited in the Office Action to make up for deficiencies in Feinberg. However,

none of the deficiencies in Feinberg identified above with respect to the 35 U.S.C. 102(b) rejection of the independent claims is disclosed or suggested in Newton et al. or Corcoran et al. Consequently, Feinberg in view of Newton et al. and Corcoran et al. are no better at disclosing the inventions of claims 1, 13, 24, 28, 39 or 49 than is Feinberg by itself. Further, Newton et al. and Corcoran et al. do not suggest the deficiencies of Feinberg noted above. Therefore, the arguments set forth above with regard to the 35 U.S.C. 102(b) rejection of claims 1, 13, 24, 28, 39 and 49 are equally applicable to the 35 U.S.C. 103(a) rejection of claims 6, 7, 9-11, 17, 18, 20-22, 32, 33, 35-37, 42, 43 and 45-47. It is respectfully requested that claims 6, 7, 9-11, 17, 18, 20-22, 32, 33, 35-37, 42, 43 and 45-47 be allowed.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted a full and complete response to the Office Action has been made. The claims are in condition for allowance, and allowance of the claims is respectfully requested.

The Applicant believes that no fee is due with this Response. If a fee is due, please charge Deposit Account No. 08-2442. Further, Applicant believes that no extension of time is necessary to file this Response. However, if an extension of time is needed, please consider this as a petition for a one-month extension of time.

The Examiner is invited to call applicant's attorney if any questions remain following review of this response. If it will

help, the undersigned is willing to explain by telephone or in person, the reasons the claims are allowable.

Respectfully submitted,



R. Kent Roberts
Attorney for Applicant
Registration No. 40,786

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Hodgson Russ LLP
One M&T Plaza, Suite 2000
Buffalo, NY 14203-2391